

Appl. No. 09/784,622  
Amendment and/or Response  
Reply to Office action of 10 March 2006

Page 6 of 8

### REMARKS / DISCUSSION OF ISSUES

Claims 1, 4-13 and 19-27 are pending in the application. Claims 2-3 are newly canceled, and claims 26-27 are newly added.

The Office action rejects claims 1, 4-23, and 19-25 under 35 U.S.C. 103(a) over McLain (USP 6,493,758) and Taylor (USP 6,643,510). The applicant respectfully traverses this rejection.

The Examiner's attention is requested to MPEP 2143, wherein it is stated:

"THE PRIOR ART MUST SUGGEST THE DESIRABILITY OF THE CLAIMED INVENTION ... The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). ... The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)".

The applicant respectfully maintains that there is no suggestion in either McLain or Taylor to combine these teachings.

McLain teaches reformatting content material for downloading to a lesser-featured mobile device for off-line viewing.

Taylor teaches providing satellite communications to aircraft to provide passengers with on-line access to the Internet.

One of ordinary skill in the art would not be lead to combine McLain and Taylor, because Taylor's invention effectively obviates the need for McLain's invention. Further, because these teachings are effectively orthogonal to each other, the applicant respectfully maintains that their combination would not teach or suggest the applicant's invention. With Taylor's teaching, each aircraft provides on-line access, and therefore there would be no need to provide the applicant's claimed mobile storage medium before the user boards the aircraft.

Because there is no suggestion to combine McLain and Taylor, and because a combination of McLain and Taylor will not provide the applicant's claimed invention, the applicant respectfully maintains that the rejection of claims 1, 4-13, and 19-25 under 35 U.S.C. 103(a) over McLain and Taylor is unfounded, per MPEP 2143.

Appl. No. 09/784,622  
Amendment and/or Response  
Reply to Office action of 10 March 2006

Page 7 of 8

Further, the Examiner's attention is requested to MPEP 2142, wherein it is stated:

"To establish a *prima facie* case of obviousness ... the prior art reference (or references when combined) *must teach or suggest all the claim limitations*... If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness."

Claim 1, upon which claims 4-11 depend, is amended to include the use of a publicly accessible access point at an airport, spaceport, boat dock, train station, or bus stop, to effect the transfer of select information content to a mobile storage device.

The Office action acknowledges that McLain does not teach transferring data to a mobile storage medium at an airport, spaceport, boat dock, train station, or bus stop.

The Office action asserts that "Taylor teaches a method of providing communication while traveling on an airplane or similar mobile platforms". The applicant concurs with this assertion, but notes that this teaching of Taylor does not address the claimed limitation of transferring data to a mobile storage medium at an airport, spaceport, boat dock, train station, or bus stop.

Claim 12, upon which claim 13 and newly added claim 27 depend, claims a method that includes, at a transit terminal, enabling transfer of information content between the repository and a mobile storage medium, and subsequently providing access to the information content at an assigned travel location in a transportation means.

The Office action acknowledges that McLain does not teach transferring information to a mobile storage medium at a transit terminal.

Taylor does not teach downloading information to a mobile storage medium, and thus cannot be said to provide this stored information to an assigned location in the transportation means.

Appl. No. 09/784,622  
Amendment and/or Response  
Reply to Office action of 10 March 2006

Page 8 of 8

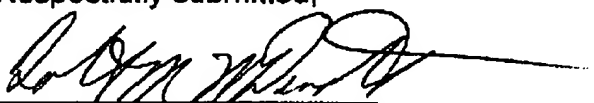
Claim 19, upon which claims 20-26 depend, claims a method that includes determining the information content that is of interest to a passenger before the passenger's aircraft departs a terminal, transferring the information content from an information network to a storage medium, and providing the information content from the storage medium to the passenger while the aircraft is in flight.

Neither McLain nor Taylor teaches determining information content that is of interest to a passenger before the passenger's aircraft departs the terminal, and the Office action fails to identify where either McLain or Taylor provides this teaching. Further, neither McLain nor Taylor teaches providing the selected and stored information content to the passenger while the passenger's aircraft is in flight, and the Office action fails to identify where either McLain or Taylor provides this teaching.

Because both McLain and Taylor fail to teach or suggest each of the limitations of each of the independent claims, the applicant respectfully maintains that the rejection of claims 1, 4-13, and 19-25 under 35 U.S.C. 103(a) over McLain and Taylor is unfounded, per MPEP 2142.

In view of the foregoing, the applicant respectfully requests that the Examiner withdraw the rejections of record, allow all the pending claims, and find the application to be in condition for allowance. If any points remain in issue that may best be resolved through a personal or telephonic interview, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below.

Respectfully submitted,



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